

Docket No.: IN-1078

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By: Wm. Green

Date: March 30, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applic. No. : 09/901,526 Confirmation No: 7099
Applicant : Matthias Förster et al.
Filed : July 9, 2001
Title : Process for Producing a Microroughness on a Surface
Art Unit : 2812
Examiner : Savitri Mulpuri

Docket No. : IN-1078
Customer No. : 24131

OFFICIAL

Petition under 37 C.F.R. §1.181
(MPEP 706.07(c), MPEP 1002.02(c))

Hon. Commissioner for Patents

Sir:

This is a petition for the withdrawal of the finality of the Office action dated March 1, 2004. The issue of contention is as follows:

Claim 12 was rejected in a non-final Office action dated October 1, 2003 as being obvious over the single reference Thakur et al. under 35 U.S.C. § 103.

Applicants responded on December 17, 2003 with arguments and amendments.

Claim 12 was not amended.

In the latest Office action dated March 1, 2004, claim 12 has been rejected as being obvious over Thakur et al. in combination with Lin et al. or Yew et al. under 35 U.S.C. § 103. The rejection was made final.

Applicants believe that the finality of the Office action is in error. MPEP 706.07(c). "Switching . . . from one set of references to another by the examiner . . . will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination." Here, we have a clear-cut case of early foreclosure on the Examiner's part by presenting a new grounds of rejection that is not necessitated by applicants' amendment, without affording applicants a right to further amend the claims.

Applicants held several telephone conversations with the Primary Examiner and requested that the Examiner withdraw the finality *ex officio*. No agreement was reached, thus necessitating this petition. Under MPEP 1002.02(c)(3)(a), the petition should be decided by the Technology Center Director.

An early response is solicited.

Respectfully submitted,



For Applicants

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Date: March 30, 2004

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